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09/834,035	04/11/2001	Henry Ross Perot	3063:26	1760

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EXAMINER

DASS, HARISH T

ART UNIT PAPER NUMBER

3693

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/834,035	<b>Applicant(s)</b> PEROT ET AL.	
	<b>Examiner</b> Harish T. Dass	<b>Art Unit</b> 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 50-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/6/2006 has been entered.

Claims 17-18, 28-29, 40 are canceled.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nieboer et al (hereinafter Nieboer – US 6,418,419) in view of Kalina (US 6,243,688).

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Re. Claim 1, Nieboer discloses a system, method and apparatus [Abstract; Figures], an identifier that identifies a customer relative to an ownership position in a company [C11 L1-L61],

a transactional component that facilitates an economic transaction [Abstract; C1 L5-L42],

a transactional relay component, communicatively coupled to the transactional component, that facilitates a response to a server system regarding the economic transaction, the response including the identifier for the server system to locate additional information on the customer and to associate the economic activity with the customer [Figures 1-3; C5 L15 to C6 L40].

Nieboer does not explicitly disclose wherein the economic transaction comprises a purchasing or ordering of goods or services from the company, one or more economic transactions representing economic activity, and economic activity with the customer for determining entitlement of ownership of stocks in the company.

However, Kalina discloses these features [Abstract; col. 1 lines 14-25, 40-48; col. 2 lines 12-16, 30-33, 45-48; col. 5 lines 51-57; claims 1, 5-6, 13; entitlement = eligibility] to provide incentives to customer to participate in loyalty program who will obtain reward points as incentive for economical gain as he/she makes transaction or purchases and the merchant retains the customer base. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosure of Nieboer and Kalina to provide an incentive to those customers/consumers who participate in loyalty program and accumulate reward points (frequent flyer points)

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where the consumer will be able to exchange its purchase credit awards to investment vehicle.

Re. Claims 2 and 4, Nieboer discloses wherein the client communicates to the server through an interconnected network [Figures 1-3; C1 L5-L42; C2 L40-L43], and wherein the economic transaction is a transaction taking place through an interconnected network [Figures 1-3; C1 L5-L42; C2 L40-L43].

Re. Claims 3, 5-12 Nieboer discloses wherein the transactional component is circuitry facilitating a transaction (terminal) [C22 L47-L50], the other source comprising a personal digital assistant (workstation such as PC) [C20 L37-L60]. And wherein the identifier is received from another source (database) [C3 L33-L35]. Nieboer or Kalina does not explicitly disclose wherein the transactional relay component is a mass storage device (RAM, hard drive, etc),

wherein the transactional component is a web browser, wherein the transactional relay component is a wireless network interface, the other source comprising a wireless networking device, the other source comprising a wireless device, and the other source comprising digital smart card.

However, a web browser, a wireless network interface, the other source comprising a wireless networking device, the other source comprising a wireless device and the other source comprising digital smart card are will known method/mode of communications and identification (smart card), and it would have been obvious at the

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time the invention was made to a person having ordinary skill in the art to modify the disclosures of Nieboer and include wireless communication system and web browser to use the capability of these new common mode of communication which provides the user more flexibility to trade remotely and smart card to identify the customer.

Re. Claim 48, Nieboer discloses wherein the server system associates the economic activity with the ownership position of the customer [C5 L15 to C6 L40].

Re. Claim 49, Nieboer or Kalina does not explicitly disclose makes available the ownership position according to the economic activity of the customer, wherein the ownership position is depending upon the economic activity. However, it is well known that a partner in business, mutual fund owner or stock holder of a company is an owner of part of the business, mutual fund or company assets which is proportional to his/her holdings. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Nieboer and Kalina and include an accounting system to provide a method to calculate the portion of the ownership of the holdings and adjust the ownership accordingly.

Claims 13-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nieboer in view of Kalina and Martin et al, 1991, "Basic financial Management", 5th Edition, Prentice Hall Inc., ISBN 0-13-060807-6 (hereinafter Martin).

Re. Claims 33, 38-39 Nieboer discloses monitoring economic activity associated with the individual [see entire document of Nieboer particularly; Abstract; Figures 1-3, 16; C1 L5-L41; C2 L18-L22; C15 L50 to C16 L67];

and limiting the risk associated with the first type of ownership to an amount less than the investment [C3 L15-L21; C11 L1-L60; C19 L64-L67], and wherein the predefined criteria (constraints) is a level of economic activity [col. 2 line 55 to col. 5 line 10]. Nieboer does not explicitly disclose - offering an individual an opportunity to convert the individual's first type of ownership in the entity to the second type of ownership interest based upon predefined criteria, wherein the first ownership interest is preferred stock, and wherein the second ownership interest is common stock, and wherein the economic transaction comprises an acquisition of goods or services from the company, one or more economic transactions representing economic activity, and economic activity with the customer for determining entitlement of ownership of stocks in the company. Nieboer does not explicitly disclose - offering an individual an opportunity to convert the individual's first type of ownership in the entity to the second type of ownership interest based upon predefined criteria, wherein the first ownership interest is preferred stock, and wherein the second ownership interest is common stock. However, Martin disclose offering an individual an opportunity to convert the individual's first type of ownership in the entity to the second type of ownership interest based upon predefined criteria, wherein the first ownership interest is preferred stock, and wherein the second ownership interest is common stock. (preferred stock or first type ownership and common stock or second type ownership) [see chapter 20 of Martin pages 743-757,

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specially pages 1 and 747] to allow the individual to convert his/her income type security such as preferred stocks (stable income) to different type of security such as common stocks and benefit from rise in the price of common stock.

Kalina discloses wherein the economic transaction comprises an acquisition of goods or services from the company, one or more economic transactions representing economic activity, and economic activity with the customer for determining entitlement of ownership of stocks in the company [Abstract; col. 1 lines 14-25, 40-48; col. 2 lines 12-16, 30-33, 45-48; col. 5 lines 51-57; entitlement = eligibility] to provide incentives to customer to participate in loyalty program and retain the customer base. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosure of Nieboer, Kalina and Martin to provide an incentive method for consumers to participate in loyalty program where the consumer will be able to exchange its purchase credit awards to investment vehicle.

Re. Claims 34-37, Nieboer discloses the step of monitoring taking place through an interconnected network [C1 L5-L13; C1 L32-L33; C2 L42] and wherein the economic activity is effectuated by a network appliance (terminal) [C22 L47-L50]. Nieboer does not explicitly disclose monitoring occurring over a web browser, and wherein the economic activity is effectuated by a wireless device. However, web browsers and wireless communication systems are well known, and it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Nieboer and Martin to include wireless communication system and web



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browser to use the capability of these new common mode of communication which provides the user more flexibility to trade remotely.

Re. Claim 41, Martin further discloses wherein the first ownership interest has an expiration time [Page 745] to allow the owner to convert the security before number of years have passed. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Nieboer and include an expiration time for the first ownership interest to allow the owner to change the security per specified time stated in original issue.

Re. Claims 42-47, Nieboer discloses the step of limiting the risk comprising investing a portion a proceeds from the investment into a fixed income investment (bond) [C1 L5-L13; C15 L50 to C18 L50], the step of limiting the risk comprising investing a portion a proceeds from the investment into a bond (treasury to bonds) [C1 L5-L13; C15 L50 to C18 L50], the step of limiting the risk comprising investing a portion of the amount of investment with a guarantor (option trader) [C1 L5-L13; C15 L50 to C18 L50]. Neither Nieboer nor Martin explicitly discloses the step of limiting the risk comprising securing a financial guarantee from a third party, wherein the amount less than the investment is zero, and wherein the amount less than the investment is less than 20% of the investment amount. However these are will-known features to one skill in the art of trading. It would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to modify the disclosures of Nieboer and Martin and specify the risk level, which is acceptable to investor (trader) in case of losses.

Re. Claim 13, Nieboer discloses a transactional reception component that receives information on an economic transaction relating to an individual [Figure 1 # 1; C4 L5-L10], a transactional processing component, communicatively coupled to the transactional reception component, that determines in what form the individual may participate in ownership of the company [C1 L5-L13; C1 L32-L33; C2 L40-L44; C22 L47-L50], and the risk associated with the first form of ownership being limited to a predetermined amount, the predetermined amount being less than an initial investment of the individual in the first form of ownership [C3 L15-L21; C11 L1-L60; C19 L64-L67], and a data storage medium, communicatively coupled to the transactional processing component, that stores information on ownership rights in the company relating to the individual (database) [C8 L18] and level of economic activity (conditional offer and number of items ... relevant activity) [C3 L48-L67; also C1 L5-L41; C2 L18-L22; col. 2 line 55 to col. 3 line 21; C15 L50 to C16 L67]. Nieboer does not explicitly disclose wherein the economic transaction comprises a purchasing or ordering of goods or services from the company, one or more economic transactions representing economic activity, and the transactional processing component determining that the individual is entitled to convert a first form of ownership in the company to a second form of ownership and .

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However, Kalina discloses wherein the economic transaction comprises a purchasing or ordering of goods or services from the company, one or more economic transactions representing economic activity and according to level of the economic activity [Abstract; col. 1 lines 14-25, 40-48; col. 2 lines 12-16, 30-33, 45-48; col. 5 lines 51-57; claims 1, 5-6; entitlement = eligibility and reward] to provide incentives to customer to participate in loyalty program and retain the customer base. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Nieboer and include economic transaction as disclosed by Kalina, to provide an incentive method for consumers to participate in loyalty program where the consumer will be able to exchange its purchase credit awards to investment vehicle. Martin disclose the transactional processing component determining that the individual is entitled to convert a first form of ownership in the company to a second form of ownership (preferred stock or first type ownership and common stock or second type ownership) [see chapter 20 of Martin pages 743-757, specially pages 1 and 747] to allow the individual to convert his/her income type security such as preferred stocks (stable income) to different type of security such as common stocks and benefit from rise in the price of common stock. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Nieboer and Kalina and include determining that the individual is entitled to convert a first form of ownership in the company to a second form of ownership as disclosed by Martin, to allow the individual to convert his/her income type security such as preferred stocks

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(stable income) to different type of security such as common stocks and benefit from rise in the price of common stock.

Re. Claims 20-21, Martin further discloses wherein the first form of ownership is a preferred stock, and wherein the second form of ownership is a common stock [Martin - pages 743-757, specially pages 1 and 747]. to allow the individual to convert his/her income type security such as preferred stocks (stable income) to different type of security such as common stocks and benefit from rise in the price of common stock.

Re. Claims 14-16 and 19, neither Nieboer nor Martin explicitly discloses wherein the transactional reception component is an interface to an interconnected network, wherein the transactional reception component is a mass storage device reader, and wherein the transactional reception component is a keyboard, and wherein the data storage medium is a semiconductor memory. However these are found in most client/server system (e.g. online trading systems).

Re. Claims 22-23, claims 22-23 are rejected with same rational claim 42-47.

Re. Claims 24-27, claims 24-27 are rejected with same rational as claims 13-16.

Re. Claim 30, claim 30 is rejected with same rational as claim 19.

Re. Claims 28, 31 and 32, claims 28, 31-32 are rejected with same rational as claim 17, 20-21.

***Response to Arguments***

1. Applicant's arguments filed 6/6/2006 have been fully considered but they are not persuasive. Because:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, every claim is provided with a motivation to combine and the motivation are from secondary reference. For example: Claim 1, the motivation to combine is stated "to provide incentives to customer to participate in loyalty program who will obtain reward points as incentive for economical gain as he/she makes transaction or purchases and the merchant retains the customer base".

Regarding applicant's comment (page 13) recites "To support the conclusion that ...in light of the teachings of the references." Applicant has failed to provide any limitation that is not considered.

Regarding applicant's comment (page 14) recites "associate the economic activity with ..." is responded in the claims. For example, converting credit award to ownership of the investment vehicle including a stocks (claims 5-6 and 13).

Regarding applicant's comment (page 14) "Claim 13. For example ... associating the economic activity", this limitation is not claimed as described by the applicant. Nieboer disclosed workstation is capable of displaying the viewer to monitor the activities of their trade (col. 2 lines 18-22).

Regarding applicant comments that withdrawn claims (50-68) is improper. See previous office action dated 3/15/2006. Claims 50-68 changed the scope of the originally presented claims limitations.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

Business Wire "Corporate Profile for Takes.com Inc., dated Aug. 6, 1999", Business Editors. New York: Aug 6, 1999. pg. 1 (ProQuest document ID: 43725996 - <http://proquest.umi.com/pqdweb?did=43725996&sid=6&Fmt=3&clientId=19649&RQT=309&VName=PQD> ) discloses registered member of the Take.com Inc., are able to reap the benefits of use with the accumulation of warrants, which are convertible to common stock in Takes.com Inc.

US 6564191 (Reddy) discloses method and system for analyzing the performance of financial securities consistent with a long-term investment strategy. In particular, the present invention relates to a computer-implemented investment analysis tool adapted for use with a dollar cost averaging (DCA) strategy wherein an investor invests in a financial security over a period of time to realize the value of compounding and to achieve a financial goal, while reducing the risk associated with putting a lump-sum investment in the market at the wrong time. Investors while recognizing that past performance does not guarantee future results, they nevertheless rely on past


performance statistics, to a varying degree, in making investment decisions, or to model their portfolios, or to track their portfolio performance and or to set financial goals.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish T Dass  
Examiner  
Art Unit 3693

  
ELLA COLBERT  
PRIMARY EXAMINER

8/29/06